

Notice of Allowability**Application No.**

09/868,601

Examiner

Callie E. Shosho

Applicant(s)

PEARS ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 8/5/03 and telephonic interview conducted 10/29/03.
2. ☒ The allowed claim(s) is/are 1-18.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|--|
| 1 <input type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input checked="" type="checkbox"/> Interview Summary (PTO-413), Paper No. <u>10/29/03.</u> |
| 5 <input type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. _____ | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) Claim 1, line 4, after "has" and before "less", delete "a Mn" and insert "number average molecular weight".

(2) Claim 3, line 4, after "has" and before "less", delete "a Mn" and insert "number average molecular weight".

(3) Claim 3, line 13, before "hydroxy", delete "a" and insert "said pendant".

(4) Claim 4, line 4, after "has" and before "less", delete "a Mn" and insert "number average molecular weight".

(5) Claim 4, line 13, before "hydroxy", delete "a" and insert "said pendant".

2. Authorization for this examiner's amendment was given in a telephone interview with Richard Steinberg on 10/29/03.

Statement of Reasons for Allowance

3. The present claims are allowable over the "closest" prior art Ikeda et al. (U.S. 5,952,429) for the following reasons:

In the office action mailed 5/21/03, paragraph 8, the examiner indicated that claims 3-6 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In response, in the amendment filed 8/5/03, applicants have rewritten claims 3 and 4 in independent form (claims 5 and 6 each ultimately depend on claim 4). Thus, as set forth in paragraph 8 of the office action mailed 5/21/03, claims 3-6 are allowable over the "closest" prior art Ikeda et al. given that there is no disclosure or suggestion in Ikeda et al. of attaching colorant to water-dissipatable polymer by reaction between pendant hydroxy group on polymer with colorant precursor and subsequently converting the colorant precursor to colorant by diazotization reaction or any disclosure of attaching colorant to water-dissipatable polymer by reaction between pendant hydroxy group on polymer with bridging compound thereby forming covalent bond there between and subsequently reacting bridging compound with colorant or colorant precursor.

The remaining claims, namely claims 1-2 and 7-18, are allowable over Ikeda et al. for the following reasons.

Ikeda et al. disclose ink jet ink comprising liquid medium and carbon black grafted polymer that comprises carbon black attached to polymer through ester or ether linkage.

However, in Ikeda et al., the polymer is attached to the carbon black through reactive group such as epoxy group, thioepoxy group, aziridine group, and oxazoline group. There is no disclosure that the polymer is attached to the carbon black by means of pendant hydroxy functional group through covalent -O- group as required in present claims 1-2 and 7-18. While Ikeda et al. do disclose attaching hydroxy functional polymer to carbon black, the hydroxy functional groups are present on the polymer in addition to the reactive group. That is, while the polymer contains hydroxy functional groups, the polymer still attaches to the carbon black through the reactive group not the hydroxy group. This is in direct contrast to present claims 1-2 and 7-18 that all require polymer having colorant attached thereto by means of pendant hydroxy functional group through a covalent -O- link.

Thus, it is clear that Ikeda et al. do not disclose or suggest the present invention.

Further, applicants' amendment filed 8/5/03 overcomes the claim objection of record.

In light of the above, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

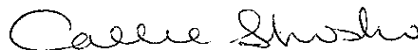
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 1714

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 703-305-0208. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
10/29/03